

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nancy C. Frye
Serial No.: 10/790,923
Filing Date: March 1, 2004
Confirmation No.: 1435
Group Art Unit: 3728
Examiner: Marie D. Patterson
Title: SHOE AND LAST

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PETITION TO REVIEW EXAMINER'S HOLDING OF NEW MATTER

In response to the Final Action issued September 22, 2010 and the Advisory Action issued February 4, 2011 in the above identified Application, this Petition to Review Examiner's Holding of New Matter respectfully requests entry of a replacement sheet of figures and the issuance of a Notice of Allowance in this Application.

REMARKS

This Application is undergoing examination pursuant to a Request for Continued Examination concurrently filed herewith. The Replacement Sheet providing changes to one figure in the Application should be entered as the Examiner has improperly held that the additions to the figure present new matter. Applicant respectfully requests reconsideration and favorable action of this Petition.

The drawings stand objected to under 37 C.F.R. §1.83(a) as not showing every feature of the invention specified in the claims. Attached herewith is a Replacement Sheet showing changes made to FIGURE 14 addressing matters raised by the Examiner. The Examiner has stated that the changes to FIGURE 14 present new matter. For reference, also attached herewith is a copy of original FIGURE 14. The feature of Claims 8, 9, 16, and 20 indicated by the Examiner as not being shown in the drawings is a midsole. FIGURE 14 has been amended to include a midsole 829 as requested by the Examiner. Applicant's specification discloses a midsole that is a feature of Claims 8, 9, 16, and 20. Support for the thickness, shape, and exact location for a midsole is provided in Applicant's specification at page 22, lines 7-12, and page 29, lines 11-13. No unusual details have been added to FIGURE 14 with the inclusion of the midsole. The Examiner's holding of new matter has no merit as a midsole and its form are explicitly disclosed in Applicant's specification and merely inadvertently not shown in the original drawings. The Examiner's position seems to be that no changes whatsoever can be made to the drawings after filing. This position is not justifiable as the M.P.E.P. clearly allows for changes to the drawings if there is support elsewhere in the Application. See M.P.E.P. §§ 608.04, 608.01(l), and 706.03(o). Therefore,

Applicant respectfully submits that the drawings are in compliance with 37 C.F.R. §1.83(a) and no new matter has been added to the Application with the inclusion of the midsole to FIGURE 14.

The drawings stand objected to for being inconsistent with Applicant's specification. The Examiner indicates that moving reference numeral 824 to any other location in FIGURE 14 is new matter. Applicant's specification discloses that a point 824 is approximately halfway across a length of shoe 810 that is also a feature of Independent Claims 1, 11, and 16. FIGURE 14 has been amended to show that point 824 is substantially halfway across a length of the shoe as requested by the Examiner. Applicant's specification discloses the location of point 824 at page 29, lines 16-20. No unusual details have been added to FIGURE 14 with the inclusion of the midsole. The Examiner's holding of new matter has no merit as the location of point 824 is explicitly disclosed in Applicant's specification and merely inadvertently not shown in the corrected location in the original drawings. The Examiner's position seems to be that no changes whatsoever can be made to the drawings after filing. This position is not justifiable as the M.P.E.P. clearly allows for changes to the drawings if there is support elsewhere in the Application. See M.P.E.P. §§ 608.04, 608.01(l), and 706.03(o). Therefore, Applicant respectfully submits that the drawings are in compliance with 37 C.F.R. §1.83(a).

In light of these considerations, Applicant respectfully submits that entry of the Replacement Sheet with changes to FIGURE 14 is appropriate and does not present new matter.

CONCLUSION

Because Applicant has demonstrated that no new matter has been added to the Application with the changes to FIGURE 14 specifically requested by the Examiner, Applicant respectfully requests a finding of no new matter, that the Replacement Sheet Examiner be entered, and a Notice of Allowance issued.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Attorneys for Applicant



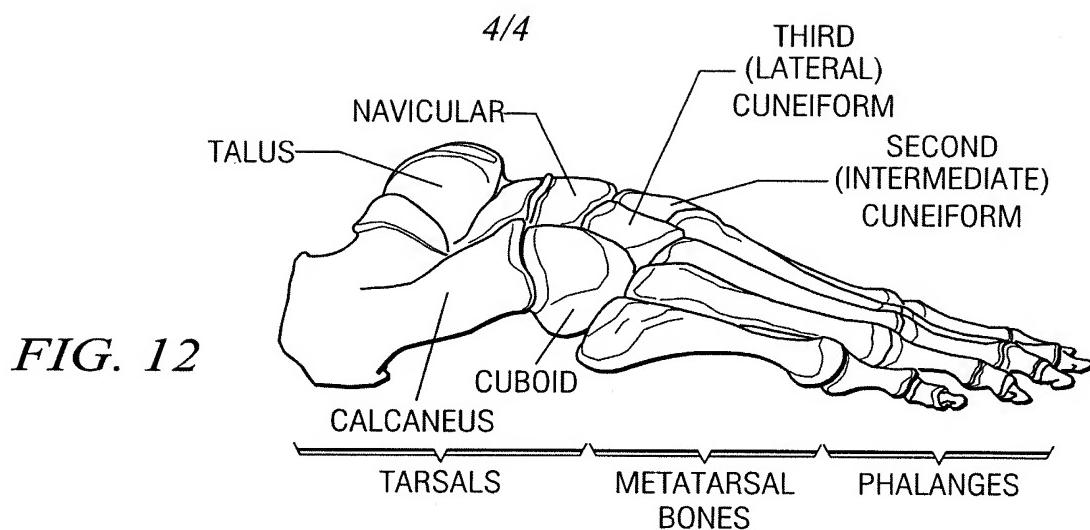
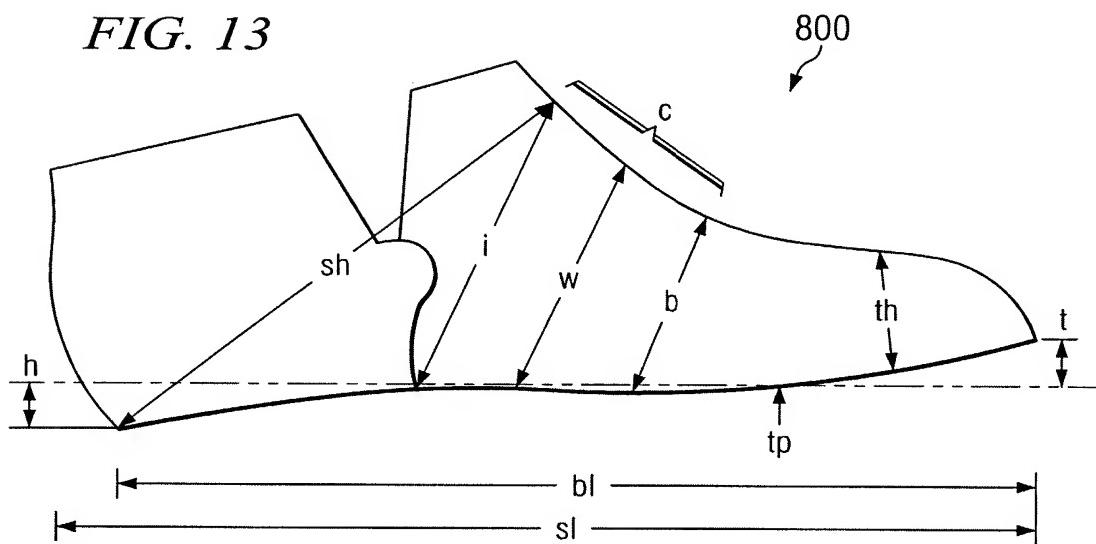
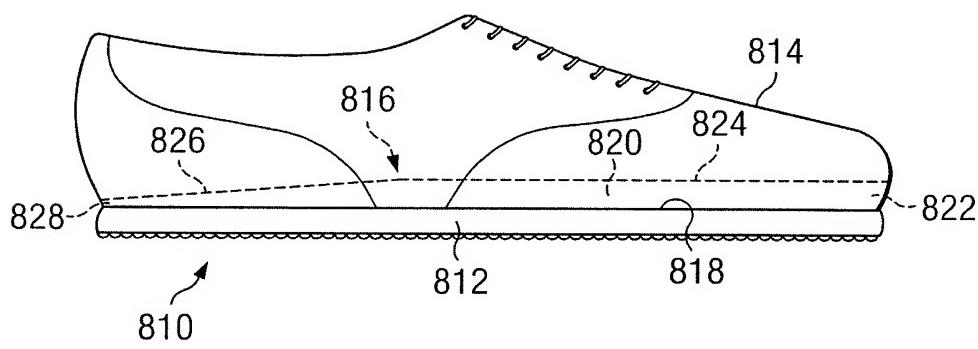
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22 March 2011

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**FIG. 12****FIG. 14**

REPLACEMENT
SHEET

